

REMARKS

Claims 1-8 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Enclosed is a Supplemental Information Disclosure Statement, Form PTO-1449, and a copy of the cited documents as requested by the Examiner.

SPECIFICATION

The specification stands objected to for certain informalities. Applicant has amended the specification according to the Examiner's suggestions. Therefore, reconsideration and withdrawal of this objection are respectfully requested.

REJECTION UNDER 35 U.S.C. § 103

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morgan in view of Alexander. Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morgan in view of Alexander and Vogel. These rejections are respectfully traversed.

A. THE CITED PRIOR ART FAILS TO TEACH EACH AND EVERY ELEMENT OF THE CLAIMS

Applicant respectfully submits that Morgan, Alexander, and Vogel fail to teach, either singly or in combination, each and every element of the claims of the present application. As is described in the specification, illustrated in the drawings, and claimed in the claims of the present application, the present invention provides a method of weaving fabrics having two plies. The warp threads for the first ply are delivered from a first warp beam. The warp threads for the second ply are delivered from a second warp beam. In other words, each warp beam delivers warp threads for a different ply. This provided a number of advantages, which are enumerated in the specification, and include for example the ability to weave fabrics having different materials for each ply.

In contrast, Morgan merely teaches a fabric and method of making the same that includes two plies that are connected by "tie" warp threads common to both plies. However, unlike the present invention, Morgan weaves the upper ply F and the lower ply F' from a single warp beam. That is, as seen at Col. 3, lines 12-17, F is the upper ply, F' is the lower ply, warp threads 1 and 1a are the warp threads for the upper ply, and warp threads 2 and 2a are the warp threads for the lower ply. With particular reference to Col. 3, lines 29-38, Morgan states "[t]he usual type of loom capable of weaving a double cloth plush or pile fabric is employed in our process, and we deliver the component warp threads from three separate warp beams: (1) from one warp beam or roll are delivered warp threads 1 and 1a, and 2 and 2a; (2) a second warp beam supplies "tie" warp threads 3, 4. . ." It should be readily apparent that Morgan DOES NOT provide separate warp threads from separate warp beams to separately weave an

upper ply and a lower ply like the present invention. Therefore, Morgan is unable to achieve the benefits of the present invention.

Likewise, Alexander merely teaches an apparatus for feeding warp yarns as a web or sheet to a weaving machine, which is capable of maintaining constant and even tension through the use of a dancer roll (Col. 1, lines 36-40). However, it appears the Examiner is incorrectly assuming that elements Y and Y' shown in FIG. 1 are "plies," as that term is used in the present application. To the contrary, Alexander clarifies that elements Y and Y' are in fact webs of yarn—"The yarn is fed as dual webs Y and Y' on its way to the whip roll 16 (if used) of the weaving machine 17. The fabric F woven on the waving machine is thence fed over the sand roll 18 beneath the weaver's platform 19. . ." (Col. 2, line 67 to Col. 3, line 4). The yarn webs Y and Y' are NOT plies of a woven, but merely webs of yard to be weaved later. In fact, the fabric F of Alexander is NOT a two ply weave, but is merely two yarn webs Y and Y' that are brought together as a singly ply.

Therefore, Morgan and Alexander, either singly or in combination, fail to teach or suggest the claimed invention. Reconsideration and withdrawal of the present rejection are respectfully requested.

Furthermore, Vogel fails to cure the deficiencies of Morgan and Alexander. Specifically, Vogel merely teaches a terry cloth woven using multiple beams. It is clear that Vogel is completely silent with regard to using separate warp threads from separate warp beams to separately weave an upper ply and a lower ply. Reconsideration and withdrawal of the present rejection are respectfully requested.

B. THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS

Additionally, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness as required by *Graham v. John Deere Co.*, 148 USPQ 459 (1966) and MPEP § 2141. Specifically, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) *The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;*
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) *Reasonable expectation of success is the standard with which obviousness is determined.*

MPEP § 2141.01

1. THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION; HOWEVER, NEITHER MORGAN, ALEXANDER, NOR VOGEL INCLUDES SUCH SUGGESTION OF DESIRABILITY OF THE CLAIMED INVENTION.

There is no teaching, suggestion, or motivation set forth in Morgan or Alexander or Vogel to combine these references to produce the claimed invention. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01 (emphasis added); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Examiner is merely attempting to combine the teachings of the cited references to invent the present invention without any explicit motivation to combine such teachings. The most recent Office Action is completely silent of any recitation that would direct the Applicant to where such motivation can be found. The citations provided by the Examiner merely identify areas of the prior art that, as shown above, do not teach what the Examiner asserts.

It is readily apparent that neither Morgan, Alexander, or Vogel provides any teaching, suggestion, or motivation to combine their teachings. Thus, without a teaching, suggestion, or motivation clearly found in within the text of these references, it is improper to combine these references to establish a rejection of obviousness, unless the Examiner can show that such teaching, suggestion, or motivation is generally available in the knowledge of one skilled in the art.

I. A Statement That A Modification Is Well Within The Skill In The Art Is Not Sufficient By Itself To Establish *Prima Facie* Obviousness.

In the most recent Official Action, the Examiner stated at numerous locations that "[i]t would have been obvious to one of ordinary skill in the art to . . ." The Examiner then simply picks and chooses among the references elements that allegedly teach the claimed invention. However, the Examiner has failed to show any motivation within these references to make such a combination.

As appropriately stated in MPEP § 2143.01, "[a] statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually

known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)(emphasis in original); MPEP § 2143.01. That is, it is the Examiner’s burden to identify some objective reason to combine the teachings of the references. However, as stated above, the Examiner merely indicated that such combinations were “obvious to one of ordinary skill in the art.” Therefore, Applicant herein respectfully requested the Examiner to identify some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teaching.

II. The Examiner Must Present A Convincing Line Of Reasoning As To Why The Artisan Would Have Found The Present Invention Obvious.

Since, at this time, the Examiner has failed to provide any objective evidence found in the references to support the combination of these references, the Examiner must present a convincing line of reasoning as to why one skilled in the art would have combined these references. According to MPEP § 2142, it is the Examiner’s initial burden to provide some suggestion of the desirability of doing what the inventor has done. Specifically, “[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In the absence of any objective evidence or any convincing line of reasoning to combine these references, Applicant respectfully submits that each of the references, either singly or in combination, fail to teach or suggest the claimed invention and, thus, the Examiner has failed to establish a *prima facie* case of obviousness. Reconsideration and withdrawal of the present rejections are respectfully requested.

III. The Examiner's Proposed Combination Changes the Principles of Operation of the References

Applicant submits that the Examiner's proposed combination of Morgan and Alexander changes the principles of operation of each of these references. Specifically, Alexander is directed to forming a single ply weave article; however, Morgan is directed to forming a two ply weave article having a "tie" warp thread interspersed therein. The combination of Morgan and Alexander contravenes established principles set forth in MPEP § 2143.01. Specifically, MPEP § 2143.01 states that "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teaching of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959)." Accordingly, in light of the above, Applicant submits that such a combination is improper and may not be used as a *prima facie* obvious combination. Reconsideration and withdrawal of the present rejection are respectfully requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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